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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/574,689	12/19/95	APPINO	J 5023/P58317A

15M1/0607
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EXAMINER

ART UNIT	PAPER NUMBER
1502	3

DATE MAILED: 06/07/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 10 - 27 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 10 - 27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☒ received in Application No. (Series Code/Serial Number) 08/291,434
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s): _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

BEST AVAILABLE COPY

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III. DETAILED ACTION

The Abstract of the Disclosure is objected to because it is not limited to a single paragraph. Correction is required. See M.P.E.P. § 608.01(b).

This application is informal in the arrangement of the specification.

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of Specification

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below.

- (a) Title of the Invention.
- (b) Cross-References to Related Applications (if any).
- (c) Statement as to rights to inventions made under Federally-sponsored research and development (if any).
- (d) Background of the Invention.
 - 1. Field of the Invention
 - 2. Description of the Prior Art.
- (e) Summary of the Invention.
- (f) Brief Description of the Drawing.
- (g) Description of the Preferred Embodiment(s).
- (h) Claim(s).
- (i) Abstract of the Disclosure.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 10-27 are rejected under 35 U.S.C. § 103 as being unpatentable over McCrea et al.

McCrea et al. discloses topical composition that contain all four ingredients claimed (abstract, claims). The compositions contain (1) a cosmetic or therapeutic agent (abstract, columns 7-8); (2) the identical linear volatile silicone, namely, hexamethyl disiloxane (col. 9, line 58, claim 10); (3) silica as the suspending agent (col. 10, abstract); and (4) other optional/conventional ingredients (columns 15-16).

The instant invention is directed towards a topical sprayable composition containing hexamethyl disiloxane, therapeutic/cosmetic agent, silica powder (optional) and conventional additives or fillers (optional). Furthermore, this composition is contained in a conventional delivery device, absent evidence to the contrary. The method of spraying the topical composition onto the skin is nominal and inherent to the claimed composition.

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The cited analogous art lacks a specific disclosure of the %wts. claimed. However, it would be prima facie obvious to optimize the amounts (%wt.) of the ingredients in view of the disclosure of McCrea et al. and deliver it topically via conventional delivery devices.

Moreover, the open language "comprising" renders inclusion of the features/ingredients other than those specifically recited in the instant claims.

Note that the claims are directed towards a composition per se. No comparative data over the closest prior art demonstrating any unexpected results and/or improvements have been presented. No criticality of the concentrations of the ingredients or the device has been established. From the totality of the teachings of the cited art, the claimed topical composition would have been rendered prima facie obvious. In reaching this conclusion, the examiner emphasizes that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure [See *In re Bozek*, 163 USPQ 545 (CCPA 1969)].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raj Bawa, PhD, whose telephone number is (703) 308-2423. The examiner can normally be reached on Tuesday-Friday from 7:30a.m. to 6:00p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, T.K. Page, can be reached on (703) 308-2927. The fax phone number for this Group is (703) 305-5408.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.



RAJ BAWA, Ph.D.
PRIMARY EXAMINER
GROUP 1500

Bawa:css
June 3, 1996